

**AMENDMENTS TO THE DRAWINGS**

The attached "Replacement Sheet," which includes changes to Figure 4, replaces the original sheet including Figure 4.

Attachment: Replacement Sheet

**REMARKS**

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1-20 are pending in this application. Claims 1, 5-15 and 17-20 are amended. Claims 2-4 and 16 are cancelled. Claims 1, 15 and 17-20 are independent claims.

Applicants respectfully note the present action indicates that the drawings have been accepted by the Examiner. Action, summary at 10.

**Foreign Priority**

Applicants respectfully note that the present action does not indicate that the claim to foreign priority under 35 U.S.C. §119 has been acknowledged or that certified copies of all priority documents have been received by the U.S.P.T.O. Applicants respectfully request that the Examiner's next communication include an indication as to the claim to foreign priority under 35 U.S.C. §119 and an acknowledgement of receipt of the certified copies of all priority documents.

**Provisional Double Patenting Rejections**

Claims 1-16 stand provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/766,193. Applicants acknowledge this provisional rejection, and will take the appropriate steps to address this rejection once the claims in the present application and the claims in pending application No. 10/766,193 are indicated as including allowable subject matter since this provisional rejection is based on claims that may change. Further, Applicants respectfully request the Examiner reconsider this rejection in view of the amended claims. Moreover, Applicants respectfully submit claims 1 and 5-15 of the current application and

claims 1-34 of copending Application No. 10/766,193 are patentably distinct, as detailed below. Claims 2-4 and 16 are cancelled.

Applicants submit that to establish a *prima facie* case of nonstatutory-type double patenting rejection, the Examiner must first identify the inventions claimed in the claims under consideration and in the reference patent claims. The Examiner must then establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person having ordinary skill in the art.

Based on U.S. case law, the Examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a); the burden of proof would then shift to the applicant to rebut the *prima facie* case. *See In re Longi*, 225 USPQ 645, 651 (Fed. Cir. 1985).

On page 2 of the Office Action, Examiner states that "although the conflicting claims are not identical, they are not patentably distinct from each other." More specifically, the Examiner states that "both inventions relate to managing reproduction of images and related data associated with the images with the related data being graphic data and subtitle data." Further, the Examiner states that "both inventions also relate to multiplexing the images and the related associated data into transport stream and packetized elementary streams." However, amended independent claim 1 of the current application recites *inter alia* "the playitem including a packet identifier information field indicating the **packet identifier (PID) of the transport stream packets associated with the playitem.**" Claims 1-34 of copending application No. 10/759,460 do not claim any features relating to a packet identifier (PID), much less a relation between the packet identifier (PID) and the playitem. Amended independent claims 15 and 17-20 are at least somewhat similar to claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection to the above claims.

**Rejections under 35 U.S.C. § 101**

Claims 1-16 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully traverse this rejection for the reasons detailed below.

The Examiner states that the “claimed invention would have been statutory if worded to include computer program embedded in a computer readable medium”. While Applicants have amended claims 1 and 5-15 to include “computer-readable medium,” Applicants respectfully submit that the Examiner has incorrectly characterized the need for the additional language “computer program”. The Manual of Patent Examining Procedure (MPEP) provides guidance on the difference between “nonfunctional descriptive material” and “functional descriptive material”. In particular, MPEP § 2106.01 states the following.

In this context, “functional descriptive material” consists of **data structures** and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5<sup>th</sup> ed. 1993).) “Nonfunctional descriptive material” includes but is not limited music, literary works and a compilation or mere arrangement of data.

(Emphasis added.)

Accordingly, Applicants respectfully submit that “a computer-readable medium having a data structure for managing reproduction of data streams,” as recited in amended independent claim 1 is a medium storing **functional** descriptive material.

MPEP § 2106.01(I) further states, regarding **functional** descriptive material, that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.”

Accordingly, the computer-readable medium recited in claim 1 includes a navigation area configured to store a playlist for **managing playback of the data stream**. The playlist includes a playitem indicating a playing interval of the data stream. The playitem also includes a packet identifier information field indicating a packet identifier (PID) of transport stream packets associated with the playitem. Therefore, claim 1 is clearly directed towards patentable, statutory subject matter.

Amended independent claim 15 is at least somewhat similar to claim 1 and therefore patentable for at least somewhat similar reasons. Claims 5-14 are patentable by virtue of their dependency on independent claim 1. Claims 2-4 and 16 are cancelled. Applicants, therefore, respectfully request that the rejection to claims 1-16 under 35 U.S.C. § 101 be withdrawn.

#### **Rejections under 35 U.S.C. § 102**

Claims 1-18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kanazawa et al. (U.S. Patent Number 6,580,870, herein “Kanazawa”). Applicants respectfully traverse this rejection for the reasons detailed below.

Independent claims 1, 15 and 17-18 are amended to incorporate part of the subject matter of claims 2-4. More specifically, amended claim 1 recites *inter alia* “the transport stream packets having respective packet identifiers (PID)” and “the playitem including a packet identifier information field indicating the packet identifier (PID) of the transport stream packets associated with the playitem.”

On Pg. 5, Ln. 6-10, of the Office Action, the Examiner relies on Col. 13, Ln. 31-36 of Kanazawa as disclosing packet identifier information indicating the transport stream packet associated with the playitem. Specifically, the Examiner cites Col. 13, Ln. 30-32, of Kanazawa as teaching that at each cell has a navigation pack (NAVI) at the head. But, at Col. 13, Ln 35-45, Kanazawa teaches that a navigation pack is “composed of a disk search

information (DSI) pack and presentation control information (PCI) pack.” Moreover, the DSI pack is disclosed as being “used as search information for the reproduce start address in special playback, such as fast-forward or rewind.” While the PCI is disclosed as being “used to change angles in multiangle playback or display highlight information for executing a navigation command.” Therefore, a NAVI, which is composed of a DSI and a PCI, **does not include a packet identifier**. As such, a cell, which includes a NAVI, also **does not include a packet identifier**. Since a cell is not disclosed as having a packet identifier, Kanazawa can also not disclose a “**playitem including a packet identifier information field** indicating the packet identifier (PID) of the transport stream packets **associated with the playitem**.” Therefore, Kanazawa fails to teach or disclose “the transport stream packets having respective packet identifiers (PID)” and “the playitem including a packet identifier information field indicating the packet identifier (PID) of the transport stream packets associated with the playitem,” as recited in independent claim 1.

For at least the foregoing reasons, independent claim 1 is patentable. Independent claims 15 and 17-18 are at least somewhat similar to independent 1 and therefore patentable for reasons at least somewhat similar to claim 1. Claims 5-14, are patentable by virtue of their dependency on one of independent claims 1, 17 and 18. Claim 2-4 and 16 are cancelled. Applicants, therefore, respectfully request that the rejection to claims 1-18 under 35 U.S.C. § 102(e) be withdrawn.

### **Rejections under 35 U.S.C. § 103**

Claims 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Monahan (U.S. Pub. No. 2004/0141436) and in view of Kanazawa et al. (U.S. Patent Number 6,580,870). Applicants respectfully traverse this rejection for the reasons detailed below.

Even assuming *arguendo* that Monahan could be combined with Kanazawa (which Applicants do not admit), Monahan still fails to cure the deficiencies of Kanazawa with

respect to amended independent claim 1. Amended independent claims 19 and 20 are at least somewhat similar to claim 1 and therefore at least patentable for similar reasons. Applicants, therefore, respectfully request that the rejection to claims 19 and 20 under 35 U.S.C. § 103(a) be withdrawn.

**CONCLUSION**

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

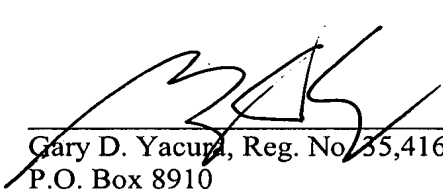
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura, Reg. No. 35,416, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By

  
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Gary D. Yacura, Reg. No. 35,416  
P.O. Box 8910  
Reston, Virginia 20195  
(703) 668-8000

GAY/NKP:bmd